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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,421	03/13/2001	Anthony Angelo Agoni	ALAW.001A	3477
20995	7590	06/16/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			BLECK, CAROLYN M	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3626	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/808,421

Applicant(s)

AGONI ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 74-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed on 21 April 2006.

Claims 1-6 and 74-75 are pending. Claims 7-73 and 76-78 have been cancelled.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 and 74-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) The rejections of claims 1-6 and 74-75 under 35 U.S.C. § 112, second paragraph, are hereby withdrawn due to the amendment filed on 21 April 2006.

***Claim Rejections - 35 USC § 101***

4. The rejection of claims 1-6 and 74-75 under 35 U.S.C. § 101 is hereby withdrawn.

***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Rizzo et al. (6,470,338).

(A) Claims 1, 2, and 74 have been amended to add “a computer-based” communication-enhancing system. As per this limitation, Rizzo discloses requiring an attorney to enter a User ID and password to enter the system, wherein the user is then able to email the clients through the system (Fig. 1C, 7, col. 3 line 59 to col. 4 line 11, col. 7 line 39 to col. 8 line 26). It is noted that entering a user ID and password into a system and then using that system to send emails to the client is considered to be a form of “receiving an agreement from said service provider to user a computer-based communication-enhancing system to provide services to the client.” Further, it is noted that submitting a user ID and password to email clients is an agreement because the only way for the attorney to email the client is to “agree” to use the system by submitting a user ID and password. Without the submission of this information, the user is unable to gain access to the computer-based system to provide services (i.e., email) to the client.

The remainder of claims 1, 2, and 74 repeat the limitations of the claims presented in the previous Office Action, and are therefore rejected for the same reasons given in the previous Office Action.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (6,470,338) in view of Thompson et al. (6,334,133).

(A) The amendments to claim 75 appear to have been made to delete a limitation, but otherwise do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action, and incorporated herein.

9. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo et al. (6,470,338) in view of Minder (6,144,943).

(A) The amendments to claim 3 appear to have been made to delete a limitation, but otherwise do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action, and incorporated herein.

(B) Claims 4-6 have not been amended, and are therefore rejected for the same reasons given in the prior Office Action, and incorporated herein.

### ***Response to Arguments***

10. Applicant's arguments filed 21 April 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 21 April 2006.

(A) At pages 6-7 of the response filed on 21 April 2006, Applicant argues that Rizzo fails to teach the limitations of claims 1 and 74.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 21 April 2006 amendment, have been fully addressed by the Examiner as being fully disclosed in view of the collective teachings of Rizzo, as detailed in the remarks and explanations given in the

preceding sections of the present Office Action and in the prior Office Action, and incorporated herein.

The Examiner respectfully submits that Rizzo discloses a system in which service providers agree to use a service-enhancing system to provide services to a client. For example, Rizzo teaches having a service provider submit a user ID and password (i.e., an agreement) in order to email clients (i.e., to use a service-enhancing system to provide services to a client). See col. 7 line 39 to col. 8 line 26.

(B) At page 8 of the response filed on 21 April 2006, Applicant argues that the combination of Rizzo and Minder fails to teach the limitations of claim 3. The Examiner respectfully disagrees with Applicant's characterization of the Minder reference. First, Rizzo teaches "receiving an agreement from a service provider." Note the discussion in paragraph A above. Second, Minder teaches that service providers enter into a contract to provide services according to particular performance standards. See col. 4 lines 3-65. Thus, the Examiner respectfully submits that at the time the invention was made, it would have been obvious to combine Rizzo and Minder. The motivation for this combination being to ensure the quality of work (Minder; col. 1 lines 52-60).

The Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048,

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1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that she has at least satisfied the burden of presenting a *prima facie* case of obviousness, since she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention as discussed above. Thus, the rejection of claim 3 is maintained.

### **Conclusion**

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300 [Official communications]

(571) 273-8300 [After Final communications labeled "Box AF"]

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(571) 273-6767 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

June 1, 2006

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER